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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,444	04/14/2004	Jorge L. Acosta	51306/805:1	8339
33451	7590	09/21/2004	EXAMINER	
PSC SCANNING, INC. - STOEL RIVES LLP C/O STOEL RIVES LLP 900 SW 5TH AVENUE PORTLAND, OR 97204			PAIK, STEVE S	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/825,444

Applicant(s)

ACOSTA ET AL.

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-56 and 77-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-34, 37, 38, 40, 41, 48-53, 55, 56, 77-84 and 88-90 is/are rejected.
- 7) ☒ Claim(s) 35, 36, 39, 42-47, 54 and 85-87 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Receipt is acknowledged of the Pre-Amendments filed April 14, 2004 and July 27, 2004. The Preliminary Amendment cancels claims 1-31 and 57-76 and adds new claims 77-90.

Claim Objections

2. Claims 32, 48, 49, 77, 83, 89, and 90 are objected to because of the following informalities:

Re claim 32, it is respectfully suggested to replace the word "a" in front of "upper" in line 4 on page 2 of the Preliminary Amendment with -- an --.

Re claim 48, it is respectfully suggested to replace the word, "it" in line 2 on page 6 of the Preliminary Amendment with -- the item --.

Re claim 49, the phrase, "to some extent" in line 5 on page 6 of the Preliminary Amendment appears to be vague and indefinite.

Re claims 77 and 83, it is respectfully suggested to replace the phrases, "the weigh plate" and "the weight scale" in lines 3 and 4 of the claim with -- a weigh plate -- and -- the weigh scale --, respectively to avoid improper antecedent basis.

Re claim 83, it is respectfully suggested to replace the word "an" in front of "security label" in the last line on page 8 of the Preliminary Amendment with -- a --.

Re claims 89 and 90, it is respectfully suggested to replace the word, "it" in line 3 of the claims with -- the item --, respectively.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 48-53, 55, and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Wike, Jr. et al. (US 2003/0075602).

Re claims 48 and 49, Wike, Jr. discloses a self checkout system and method of using the system comprising the steps of:

passing the item along an item (col. 1, [0014]-col. 2, [0017]) path and through a read volume of a data reader (scanner 30), the data reader being disposed in a housing (the entire SCOT 12 system, and see Fig. 3 showing a block diagram of each component of the system);

reading the optical label (barcode label) on the item with the data reader through a window in the housing (in particular the itemization area 22);

generating a security tag deactivation field (which overlaps with scanning field) with a security deactivation unit (EAS deactivator 18), the deactivation unit being disposed in the housing (SCOT 12), and the deactivation field being located in the item path downstream of the read volume (from left to right);

wherein once the data reader has read the optical code on the item and identified the item, activating the security deactivation field and deactivating the security tag (Fig. 7).

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Re claim 50, Wike, Jr. discloses the method as recited in rejected claim 48 stated above, further comprising:

generating a security tag detection field (by EAS detector 70) with a detection unit, the detection unit being disposed in the housing (see Fig. 3), and the detection field being located in the item path upstream of the read volume;

alerting the deactivation unit upon detection of a security tag (col. 3, [0044]).

Re claim 51, Wike, Jr. discloses a self checkout system comprising:

a housing (SCOT 12) including a window (scanning window 30a and 30b) adapted for facing a scan volume;

a data reader (scanner 30) disposed in the housing to read an item through the window as the item is passed in a sweep direction through the scan volume;

a first EAS unit (EAS detector 70) located in the housing toward an upstream side of the window, the first EAS unit comprising an EAS detector for sensing presence of EAS tags on items on an upstream side of the scan volume;

a second EAS unit (EAS deactivation device 18) located generally downstream of the scan volume, the second EAS unit comprising an EAS deactivation coil for deactivating EAS tags.

Re claims 52 and 53, Wike, Jr. discloses the system as recited in rejected claim 51 stated above, wherein the second EAS unit comprises a plurality of windings disposed about an interior (col. 6, [0070] discloses an EAS element 96 of a coil or the like. It is conventional that a coil or the like is wound a core).

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Re claim 55, Wike, Jr. discloses the system as recited in rejected claim 51 stated above, further comprising a controller (processing unit 72 in Fig. 3) receiving input from both the data reader (scanner 30) and the first EAS unit (EAS detector 70), and controlling activation of the EAS deactivation coil (EAS deactivator 18).

Re claim 56, Wike, Jr. discloses the system as recited in rejected claim 51 stated above, wherein first EAS unit comprises an EAS detector (EAS detector 70 in Fig. 6; Fig. 7) for sensing EAS tags on items approaching the scan volume.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 77-84 and 88-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wike, Jr. et al. (US 2003/0075602) in view of Williams et al. (US 5,410,108).

Re claims 77, 83, 84 and 88, Wike, Jr. discloses a self checkout system and method of using the system including an electronic article surveillance (EAS) system. The checkout system includes, among other things, a transaction terminal (58), a scanner (30), scale, and an EAS deactivator. As appreciated, all of the components are coupled by a power cable to provide a power to operate the system and a data cable to exchange data read by the scanner.

However, Wike, Jr. does not specifically disclose how the scale assembly is coupled to the scanner.

Williams et al. disclose a combined scanner and scale device. The device includes a base portion (base enclosure 30) and a weigh scale (a scale module 80) over the base portion (col. 4, ll. 4-6). The weigh plate includes an aperture (window 122) and a barcode reader (scanner module 150) between the base portion (30) and the weigh scale with reads a barcode through the aperture in the weigh plate (col. 3, ll. 42-54).

In view of Williams teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a combined scanner and scale device in addition to the self checkout system of Wike, Jr. due to the fact that a compact and integrated construction of the scanner, scale, and their associated components can be accomplished for the purposes of reducing the size and cost of manufacturing a self checkout system.

Re claims 78, 80, and 81, Wike, Jr. in view of Williams discloses the checkout system as recited in rejected claim 77 stated above, wherein the barcode reader enables the security label deactivation system following reading of the barcode (Fig. 7, col. 7, [0072]).

Re claim 79, Wike, Jr. in view of Williams discloses the checkout system as recited in rejected claim 77 stated above, wherein the security label deactivation system includes a magnetic coil assembly for sensing and deactivating a security label (col. 3, [0044]-[0046]).

Re claim 82, Wike, Jr. in view of Williams discloses the checkout system as recited in rejected claim 77 stated above. Williams discloses dimensions of the combined scanner and scale system in column 13, lines 38-50. The reference discloses an exemplary vertical dimension of 8.5 inches. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the size of the device, since it has been held that discovering

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an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Re claims 89 and 90, Wike, Jr. in view of Williams discloses the checkout system and the method of using the system as recited in rejected claim 88 stated above, wherein sensing a movement of a magnetic material in the security label (sensing a tag) and demagnetizing (deactivating the tag) the magnetic material in the security label as the item passes near a coil assembly (EAS detector 70) in the security label deactivation system (self checkout terminal 12).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 32-34, 37, 38, 40, and 41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 9-11, 13, and 29 of U.S. Patent No. 6,783,072. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the above mentioned patents. For instance, claim 32 of the present claimed invention recites "... (a) a central portion and (b) outer windings...." and claim 1 of the '072 patent recites "... a central core of magnetically active material....". The Examiner believes that claims 32-34, 37,

38, 40 and 41 of the instant application are generally identical to the claims 1, 7, 9-11 and 29 of '072 patent.

Thus, in respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of claims 1, 7, 9-11, 13, and 29 of U.S. Patent No. 6,783,072 as a general teachings for a system for data reading and EAS deactivation to perform the same functions as claimed by present application. The instant claim obviously encompasses the above mentioned patent and differs only in terminologies describing a component of the system.

Allowable Subject Matter

9. Claims 35, 36, 39, 42-47, 54, 85-87 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art of record teaches or fairly suggests the claimed system for data reading and EAS deactivation comprising, among other things, an EAS deactivation coil unit including a central core of magnetically active material and outer windings disposed around the central core. The deactivation unit is disposed in a scanner housing laterally to one side of a window and downstream of the scan volume.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tang et al. (US 5,886,336) disclose an optical scanner having a plurality of windows joined together for scanning a multisided item; Collins, Jr. et al. (US 5,588,621) disclose a


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universal mounding apparatus and method for barcode scanners allowing newer and smaller scanners to fit within the checkout counter apertures of larger scanners.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Mon - Fri (5:30am-2:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven S. Paik
Examiner
Art Unit 2876

ssp